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PATENT DEPARTMENT
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EXAMINER

CHAMPAGNE, DONALD

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3688

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/081,257	Applicant(s) MANKOFF, JEFFREY W.	
	Examiner Donald L. Champagne	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 58-90 is/are pending in the application.
- 4a) Of the above claim(s) 72-90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 58-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 53-71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A. Beginning at claim 53, line 4, “member” is new matter. The specification discloses only a “user”, which one of ordinary skill in the art would recognize as a genus of which “member” is a species. “member” has the property of voluntarily providing information or otherwise taking overt action to establish membership. No such property is disclosed in the spec.

B. Beginning at claim 53, line 5, “member/user computer network” is new matter. The specification discloses nothing which one of ordinary skill in the art would perceive to be a special network for members/users.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 53-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. “distributed to the member consumer from outside the member consumer network” is indefinite. Said “network” is not clearly defined, so it is not clear how one can be “outside” it.

Interpretation of Claim Language

5. Note on interpretation of claim terms - Unless a term is given a “clear definition” in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so “with reasonable clarity, deliberateness, and precision” (MPEP § 2111.01.III). A “clear definition” must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as “by xxx we mean”; “xxx is defined as”; or “xxx includes ... but does not include ...”. An example does not constitute a “clear definition” beyond the scope of the example.
6. The following terms are not clearly defined in the spec. and are accordingly interpreted as indicated.

A. Member computer network is interpreted to be any digital electronic (i.e., “computer”) network used by members, including the Internet (para. [0005] of the published application (US20020120627A1).

B. Secure member computer network is interpreted to be any network where access to user information is limited by any means, including by requiring a “username” and “password”, such as disclosed at para. [0017] of the published application.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claims 53-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Meyer et al. (US006915271B1).

9. Meyer et al. teaches (independent claim 53) a method of managing virtual documents (*promotional incentives*)¹ on behalf of a plurality of consumers, wherein a given virtual document comprises data associating it with one of the consumers, the method comprising:

a) establishing a network member database (*member database MMBR_DB 111*, col. 18 lines 35-38 and col. 21 lines 18-20) on a network-connected computer (*member information computer 109*) within a secure member computer network (col. 47 line 19 to col. 4 line 26, especially col. 48 lines 5-7) said network database corresponding to a plurality of member consumers (col. 47 lines 20-23), the network database having data records associated with the member consumers (*member incentive histories*, col. 21 lines 22-24) and including a set of categories (col. 21 lines 35-37);

b) receiving a first one of said virtual documents (*the clipped incentive*, col. 36 lines 48-52 and 58-67) at said network database from a document providing module (*DISPL*, col. 19 lines 27-31) in response to a member consumer's selection (*clipping*) of a first incentive offer (col. 19 lines 31-34) by a first incentive offer distributor (inherently, any first *promotion agency/author/distributor*, col. 16 lines 14-20 and col. 63 lines 51-52), the first incentive offer selection received at the network connected computer from the first incentive offer distributor (inherently, because all incentive offers are received at the network connected computer from the first incentive offer distributor, whether selected or not)², and the first virtual document having a first attribute file identifying a classification for the first virtual document (*types of offers* and *categories*, col. 39 lines 56-61 and Fig. 31), and further having data identifying a first incentive offer that is provided by the first virtual document (*The name of the promotion*, col. 22 lines 43-44);

c) extracting from the first virtual document (*the incentive or promotion*, col. 6 lines 50 to 53) data identifying the first incentive offer (*the incentive name* and *ID*, col. 6 lines 53-57), the first incentive offer distributor (*the account or service provider*, col. 7 lines 6-9), and data

¹ Meyer et al. uses this phrase as well as *promotion* and *incentive* interchangeably, although Meyer et al. does also describe an *incentive* as a component of a *promotion*, col. 16 lines 17-18.

² In addition, the act and details of selection/clipping are stored and therefore received at the network computer (col. 9 lines 39-45 and col. 21 lines 24-35).

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identifying a first business advertiser honoring the first incentive offer (*the issuer*, col. 6 lines 58-59;

d) storing information regarding the first received virtual document within first data fields in a data record associated with the identified consumer (col. 36 lines 65-67), wherein the first data fields include the data identifying the first incentive offer (*The name of the promotion*, col. 22 lines 43-44), the data identifying the first incentive offer distributor (*the account or service provider*, col. 7 lines 6-9), and the data identifying the first business advertiser (col. 23 lines 14-15);

e), f) and g): respectively repeating steps b), c) and d) for a second virtual document/*clipped incentive* (any *clipped incentive* other than the first);

h) categorizing the first and second virtual documents in the categories of the data record associated with the member consumer according to the classifications provided in the attribute files and the extracted data of the first and second virtual documents (col. 39 lines 56-61 and Fig. 31).

10. The following language in claim 53 is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01).

“distributed to the member consumer from outside the member consumer computer network”; and

“a second incentive offer distributor different than the first incentive offer distributor”.

This language is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention.

11. Meyer et al. also teaches at the citations given above claims 54, 55, 59 (where the clipping process reads on emailing), 60, 61, and 69-71.³

12. Meyer et al. also teaches claims 56-58³ (col. 7 lines 39-46); claims 62-66 (col. 5 lines 19-26 and col. 17 line 60 to col. 18 line 6); and claims 67 and 68 (col. 43 lines 58-62 and col. 44 lines 9-15).

³ With no patentable weight given to “associated/unassociated with the first/second business advertisers or the consumer by one of the incentive offer distributors” in claims 54 and 58.

Response to Arguments

13. Applicant's arguments filed with an amendment on 26 October 2009 have been fully considered in the revised rejection, which is on the same basis as the last rejection (mailed 26 May 2009). The instant amendment did nothing to overcome the rejection of record. For example, the applicant now claims a "member/user computer network", but the examiner could not find support for or clear definition of any such special network; hence, the Internet reads on this claim limitation (para. 2.B. and 6.A. above).
14. The examiner also disagrees with the applicant's interpretation of the Meyer invention. For example, applicant argues (end of first para. on p. 15 of 17) that, in Meyer, "the incentive offers ... are distributed by the network itself, and not by distinct incentive distributors". First, the claims are not limited to "distinct" incentive distributors. Second, Meyer teaches the claimed distributor (col. 16 lines 14-20 and col. 63 lines 51-52).
15. In the latter example, it sounds as if the applicant is referring to a special business entity, but distinctions among business entities are non-functional and not given patentable weight. Patentable weight can be given to *what* is done, not to *who* does it. Entity names are used as shorthand for functions, but this does not mean that patentable weight is given to the entity name. "Distributor" is merely shorthand for the distribution function. A second distributor different from the first" is not functionally meaningful and was accordingly not given patentable weight.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
19. The examiner's supervisor, Lynda Jasmin, can be reached on 571-272-6782.
20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
21. **AFTER FINAL INTERVIEW PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence in an interview request (form PTOL-413A) that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
22. Applicant may have after final arguments considered and amendments entered by filing an RCE.
23. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).

20 February 2010

/Donald L. Champagne/
Primary Examiner, Art Unit 3688